

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT R. LA MOTTE

Appeal No. 2000-1637
Application No. 09/002,808

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 5 and 7 to 12, which are all of the claims pending in this application.¹

We REVERSE.

¹ Claims 1 and 10 were amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to a dump valve operative to immediately substantially reduce or eliminate pressurized flow at the outlet to prevent damage or injury without shutting down the source of pressurized fluid (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

DeLorenzo	3,563,508	Feb.
16, 1971		
Eckerlin	3,633,619	Jan. 11,
1972		

Claims 1 to 5 and 7 to 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eckerlin in view of DeLorenzo.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 12,

mailed January 24, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 11, filed November 8, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 5 and 7 to 12 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed.

Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id.

In our view, the only suggestion for modifying Eckerlin in the manner proposed by the examiner (answer, pp. 3-5) to arrive at the claimed subject matter stems from hindsight knowledge derived from the appellant's own disclosure. The

use of such hindsight knowledge to support an obviousness rejection under

35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In that regard, we fail to see any suggestion, teaching or motivation in the applied prior art to have modified Eckerlin's device to have utilized a fluid cylinder to move his valve member (i.e., end portion 24).

Moreover, all the claims under appeal require that the claimed dump valve be capable of handling a pressure of at least 500 p.s.i. The examiner's position (answer, pp. 4-6) with regard to this limitation is that Eckerlin's device is capable of withstanding a pressure of at least 500 p.s.i. and the operating pressure is an obvious design expedient. However, the examiner has failed to produce any evidence to support this position. In our view, Eckerlin's device cannot be said to be inherently capable of handling a pressure of at least 500 p.s.i. in his passage 12. Additionally, while the

operating fluid pressure in Eckerlin's passage 12 may be an obvious design expedient (i.e., the pressures that a person of ordinary skill in the art would have utilized), there is no evidence that such pressure would be at least 500 p.s.i.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 5 and 7 to 12 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 5 and 7 to 12 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 2000-1637
Application No. 09/002,808

Page 8

DENNIS L. THOMTE
801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309

Appeal No. 2000-1637
Application No. 09/002,808

Page 9

JVN/jg